

### **REMARKS**

This paper responds to the Office Action mailed on April 19, 2006. Claims 1-9 and 31-34 are canceled and claims 40-45 are added such that claims 12-14, 17 and 40-45 are now pending in this application.

#### **§112 Rejection of the Claims**

Claim 2 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness, namely, that “said first solid substance” and “said second solid substance” lack antecedent basis. Applicant has canceled claim 2 such that the rejection is moot.

#### **§102 Rejection of the Claims**

Claims 12 and 13 were rejected under 35 U.S.C. § 102(b) for anticipation by Ward (US 5,087,273). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* '2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As part of the rejection of claims 12 and 13, the Examiner states at page 2 of the Office Action that “the enclosure is capable of functioning as claimed ‘wherein’ opening the stitching mechanism 6 allows mixing of said first solid substance with said second solid substance inside said gas-permeable enclosure.” Applicant respectfully traverses this assertion.

Applicant can not find any teaching or suggestion in Ward that the stitching mechanism 6 is opened (or is even capable of being opened). Applicant respectfully directs the Examiner’s attention column 3, lines 48-62 of Ward which appears to teach away from opening the stitching mechanism 6. Applicant notes that column 3, lines 48-62 of Ward describe permanently securing opposite faces of the envelope together.

Therefore, Applicant respectfully submits that Ward does not teach or suggest a package that includes “a mechanism segregating said first solid substance from said solid second substance, wherein opening said mechanism allows mixing of said first solid substance with said second solid substance inside said gas-permeable enclosure” as recited in claim 12. Claim 13 depends from claim 12, and is patentable over Ward for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 12 and 13 are respectfully requested.

*First §103 Rejection of the Claims*

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Holzner (US 4,534,509) in view of Japanese document 2000191053 (hereafter JP2000191053) and Pendergrass Jr. (US 5,395,047). Applicant has canceled claims 1-9 such that the rejection is moot.

*Second §103 Rejection of the Claims*

Claims 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Renner (WO 95/053237) in view of Holzner (US 4,534,509). Applicant respectfully traverses the rejection because the combination of Renner and Holzner does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Renner and Holzner.

***1. Renner and Holzner do not teach or suggest every element of claims 12-14***

The Examiner appears to acknowledge that Renner does not disclose a gas-permeable enclosure as recited in claim 12 by stating at page 4 of the Office Action that “[t]he difference between the claimed subject matter and Renner reside in a gas-permeable enclosure that permits permeation without rupture.”

The Examiner attempts to overcome the acknowledged deficiencies of Renner by combining Renner with Holzner. The Examiner states at page 4 of the Office Action that “Holzner col. 2, lines 50-59, states a pouch made of a polymer material has been developed that

permits diffusion of gas therethrough.” Applicant notes that Holzner does not describe mixing the substances that are contained in the superposed devices 2. As shown in the bottom portion of FIGS. 1 and 2, the right portion of FIG. 3 and FIG. 4 of Holzner, the superposed devices 2 are separated so that the substances within the respective devices 2 can permeate through the respective diffusion walls 6 once both devices 2 are separated from one another after being removed from a hermetically sealed bag where the devices 2 are stored. Applicant notes that the hermetically sealed bag is only described in the specification of Holzner and not shown in the FIGS.

Applicant can not find in Holzner an enclosure that segregates a first substance from a second substance yet permits opening the enclosure to allow the first substance and the second substance to be mixed together inside an enclosure. Therefore, Applicant respectfully submits that the combination of Renner and Holzner does not teach or suggest a mechanism and gas-permeable enclosure as recited in claim 12. Applicant specifically notes that Renner and/or Holzner do not teach or suggest a package that includes:

“a mechanism segregating said first solid substance from said solid second substance, wherein opening said mechanism allows mixing of said first solid substance with said second solid substance inside said gas-permeable enclosure, said gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12.

## ***II. There is no motivation or suggestion to combine Renner and Holzner***

Notwithstanding the fact that the combination of references fails to establish all of the elements of the claims, Applicant respectfully submits that the rejection fails to establish a legally sufficient motivation to combine the references. To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The Office Action states at pages 4-5 of the Final Office Action that “[i]t would have been obvious to one of ordinary skill in the art to modify the plastic foils of Renner by employing a diffusing polymer as taught by the prior art statement in Holzner, in order to provide a release of gas build up without the need of constructing a separate rupturable chamber.” Applicant respectfully traverses this assertion.

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Mere conclusory statements are unsatisfactory.

“With respect to Lee’s application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner’s conclusory statements that ‘the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software’ and that ‘another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial’ do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use ‘[use] that which the inventor taught against its teacher.’ *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).” *Lee*, at 1343, 1344.

Applicant respectfully submits that the Examiner’s statement regarding motivation is analogous to the inadequate conclusory statements made by the Examiner and Board in the *In re Lee* case. It is respectfully submitted that the Examiner’s assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

In addition, Applicant notes that (i) Holzner does not have any teaching as to mixing components within an enclosure; and (ii) Renner only teaches an enclosure that includes a cross piece 12 that must be ruptured for gas to escape from the chamber 10, 20. Applicant respectfully

submits that the only teaching or suggestion relating to a mechanism and a gas-permeable enclosure as recited in claim 12 is found in Applicant's disclosure.

Since the cited references do not describe each and every element of the claims 12-14, and there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claims 12-14 are respectfully requested.

*Third §103 Rejection of the Claims*

Claims 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Renner (WO 95/053237) in view of Muysson (US 5,164,178). Applicant respectfully traverses the rejection because the combination of Renner and Muysson does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Renner and Muysson.

***I. Renner and Muysson do not teach or suggest every element of claims 12-14***

The Examiner again appears to acknowledge that Renner does not disclose a gas-permeable enclosure as recited in claim 12 by stating at page 5 of the Office Action that “[t]he difference between the claimed subject matter and Renner reside in a gas-permeable enclosure that permits permeation without rupture.”

The Examiner attempts to overcome the acknowledged deficiencies of Renner by combining Renner with Muysson. Applicant notes that Muysson does not describe segregating and then mixing the substances that are contained in the disclosed pouch 1 (see FIG. 4 of Muysson).

Applicant can find Muysson an enclosure that segregates a first substance from a second substance yet permits opening the enclosure to allow the first substance and the second substance to be mixed together inside the enclosure. Therefore, Applicant respectfully submits that the combination of Renner and Muysson does not teach or suggest a mechanism and gas-permeable enclosure as recited in claim 12. Applicant specifically notes that Renner and/or Muysson do not teach or suggest a package that includes:

“a mechanism segregating said first solid substance from said solid second substance, wherein opening said mechanism allows mixing of said first solid substance with said second solid substance inside said gas-permeable enclosure, said gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12.

## **II. *There is no motivation or suggestion to combine Renner and Muysson***

Notwithstanding the fact that the combination of references fails to establish all of the elements of the claims, Applicant respectfully submits that the rejection fails to establish a legally sufficient motivation to combine the references. The Office Action states at page 7 that “[t]o provide the device of Renner with a plurality of apertures would have been an art recognized equivalent manner of venting gas as evidenced by Muysson.” Applicant respectfully traverses this assertion.

Applicant similarly respectfully submits that the Examiner’s statement is analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case (see quote from *Lee* case above). It is respectfully submitted that the Examiner’s assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

In addition, Applicant notes that (i) Muysson does not have any teaching as to segregating and then mixing components within an enclosure; and (ii) Renner only teaches an enclosure that includes a cross piece 12 that must be ruptured for gas to escape from the chamber 10, 20. Applicant again respectfully submits that the only teaching or suggestion relating to a mechanism and a gas-permeable enclosure as recited in claim 12 is found in Applicant’s disclosure.

Since the cited references do not describe each and every element of the claims 12-14, and there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claims 12-14 are respectfully requested.

***Fourth §103 Rejection of the Claims***

Claims 17 and 31-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Renner (WO 95/053237) in view of Holzner (US 4,534,509) as applied to claims 12-14 above, and further in view of Detrie et al. (US 2,916,197). Applicant has canceled claims 31-34 such that the rejection is moot as to those claims.

**Claim 17**

Applicant respectfully traverses the rejection because the combination of Renner, Holzner and Detrie does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Renner, Holzner and Detrie.

***I. Renner, Holzner and Detrie do not teach or suggest every element of claim 17***

As part of making the rejection, the Examiner states at page 6 of the Office Action that “[t]he difference between the claimed subject matter resides in a zipper segregating the first substance from the second substance along with a tab attached to the each layer of the package.” Applicant respectfully traverses the above assertion because as discussed above, the combination of Renner and Holzner does not teach or suggest a mechanism and gas-permeable enclosure as recited in claim 12.

In addition, Applicant respectfully submits that Detrie does not teach or suggest “a gas-permeable enclosure” because the only way that the resin mixing process disclosed in Detrie (see Detrie at col. 5, lines 32-34) makes sense is for bag 12 to be impermeable to gas. The bag 12 needs to be impermeable to gas or undesirable hardening of the mixture (or pre-mixed components) will occur before the mixture is dispensed from the bag 12. Applicant further notes that Detrie teaches at col. 3, line 21 using materials that “are impervious to humidity”.

Therefore, the cited combination of Renner, Holzner and Detrie does not appear to teach or suggest a package that includes:

“a mechanism segregating said first solid substance from said solid second substance, wherein opening said mechanism allows mixing of said first solid substance with said second solid substance inside said gas-permeable enclosure, said gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12.

Claim 17 depends from claim 12, and is patentable over Renner, Holzner and/or Detrie for the reasons argued with regard to claim 12, plus the elements in the claim.

## **II. *There is no motivation or suggestion to combine Renner, Holzner and Detrie***

The Office Action states at page 6 of the Final Office Action that “[i]t would have been obvious to one of ordinary skill in the art to modify the package of Renner by employing a zipper as taught by Detrie et al, in order to permit a more easily grasped and separated compartment.” Applicant respectfully traverses this assertion.

Applicant similarly respectfully submits that the Examiner’s statement is analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case (see quote from *Lee* case above). In addition, Applicant notes that Detrie teaches away from any type of “gas-permeable enclosure” because undesirable hardening of the mixture (or pre-mixed components) would occur before the mixture is dispensed from the bag 12. Since the cited references do not describe each and every element of the claim 17, and there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn.

Reconsideration and allowance of claim 17 are respectfully requested.



**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24 day of May, 2006.

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